

U.S. Pat. Appl. Ser. No. 10/566,811
Attorney Docket No. 10191/4496
Reply to Office Action of October 29, 2009

AMENDMENTS TO THE DRAWINGS:

The attached Replacement Sheet of a Drawing of Figures 1 and 2 replaces the original sheet of Figures 1 and 2. Approval and entry are respectfully requested.

Attachment: One (1) Replacement Sheet.

REMARKS

Claim 12 has been canceled without prejudice, claims 19 to 30 are added, and therefore claims 9 to 11 and 13 to 30 are pending in the present application.

In view of the following remarks, it is respectfully submitted that the pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the claim for foreign priority and for indicating that all certified copies of the priority documents have been received.

The drawings were objected to for a minor formality. Figure 1 has been corrected in the accompanying Replacement Sheet. Approval and entry are respectfully requested, as is withdrawal of the objection to the drawing.

Claims 9 to 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Background Information (characterized as Applicant's Admitted Prior Art ("AAPA")) by the Office Action) in view of U.S. Patent No. 4,529,667 to Shiga et al. ("Shiga").

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re*

Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejection may not be agreed with, to facilitate matters, claim 12 has been canceled without prejudice.

Further, while the rejections may not be agreed with, to facilitate matters, independent claims 9 and 13 have been rewritten to provide that *the silver layer is directly applied on a nickel layer*. It is respectfully submitted that the Shiga reference cannot be applied as suggested by the Office Action because it specifically teaches against having Nickel as its intermediary layer for its application. In this regard, it states that “if Ni intermediate layer ... is provided, it can not be [a] solution to the problem in case the silver coating of the silver-coated electric material is made further thinner and in case the electric material is exposed to high temperature in the process of making parts.” (Shiga, column 2, lines 26 to 31). The Shiga reference further states that “the Ni intermediate layer in the electric material can not solve the problems, and the soldering property of the electric material is extremely depressed, and, in some cases, the silver coating comes off.” (Shiga, column 2, lines 50 to 53).

Thus, Shiga specifically teaches against having a silver coating directly on top of nickel for its intended use. That is because Shiga apparently indicates that silver is unable to solve its problems and may even cause the silver coating to come off. Instead, Shiga provides an “intermediate coating layer made of Sn, Cd, Pd, Ru, or their alloys”. (Shiga, Abstract.) Accordingly, one skilled in the art would not find it obvious to combine the Shiga reference with the Background Information (regardless of its proper characterization), as asserted by the Office Action.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal

knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 9 and 13, as presented, are allowable, as are their respective dependent claims 10, 11, and 14 to 18. It is therefore respectfully requested that the obviousness rejections be withdrawn.

New claims 19 to 30 do not add any new matter and are supported by the present application. Claims 19 to 30 ultimately depend from claims 9 and 13 respectively, as presented, and they are therefore allowable at least for the same reasons. Additionally, each of claims 19 to 30 provides further features that are not disclosed or suggested by the Shiga reference, as any review of the Shiga reference makes plain.

Accordingly, claims 9 to 11 and 13 to 30 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending and considered claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Dated: _____

11/16/2010

Respectfully submitted,

By: _____

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